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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/561,260

Applicant(s)

COLGRAVE, JOHN

Examiner

JOSHUA MURDOUGH

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/200)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 4/12/2010

Acknowledgements

1. This action is responsive to Applicants' amendments received 18 May 2010.
2. This action has been assigned paper number 20100721 for reference purposes only.
3. Claims 17-30 are pending.
4. Claims 17-30 have been examined.

Claim Rejections - 35 USC § 112 1st Paragraph

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 21-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
7. Claim 21 recites "the registry comprising: at least one processor." Applicants have only disclosed that "client/server 10 has a processor 101" (Specification, Page 5, Line 27). The recitation of "at least one processor" covers registries with two processors or more. Because Applicants did not disclose multiple processors in their original disclosure, the limitation "at least one processor," which claims registries with more than one processor, is new matter.
8. Furthermore, Applicants disclose that it is the client/server 10 that has the processor. Applicants also disclose "a UDDI registry may be installed on any such client/server"

(Specification, Page 5, lines 23-24). Because the registry is installed on the client/server it cannot be the client/server. Because the registry is not the client/server and because Applicant's have only disclosed that the "client/server 10 has a processor 101," a registry with a processor is not necessarily present in the original disclosure. Because a registry with a processor is not necessarily present in the original disclosure, it is new matter.

9. Similarly, Applicants disclose "client/server has...a RAM volatile memory element 102, a non-volatile memory 103" (Specification, Page 5, Lines 27-29). Again, the memory elements are disclosed as part of the client/server. Because the registry is installed on the client/server it cannot be the client/server, as noted in the preceding paragraph. Because the registry is not the client/server and because Applicant's have only disclosed that the "client/server 10 ...a RAM volatile memory element 102, a non-volatile memory 103," a registry with a memory is not necessarily present in the original disclosure. Because a registry with a memory is not necessarily present in the original disclosure, it is new matter.

10. Claims 21-26 are rejected under 35 U.S.C. § 112 1st paragraph (scope of enablement). Applicants recite "said processor is configured to: receive...details associated therewith." In claim 21, the Examiner finds that the "processor" is modified by the purely functional limitation "configured to: receive...details associated therewith." Because the processor is modified by pure functional language with no limitation of structure, Applicants are claiming *all* structures for performing the claimed function. Because Applicants are claiming *all* structures for performing the claimed function and because the original specification does not enable *all* structures for performing the claimed function, claim 21 is rejected under 35 U.S.C. § 112 1st

paragraph (scope of enablement). See *Ex parte Miyazaki*, 89 USPQ2d 1207, 1215-17 (B.P.A.I. 2008)(precedential)

11. The language of claim 21 has been amended so it no longer invokes interpretation under 35 U.S.C. 112 6th paragraph because it no longer recites “means for.” Because it does not invoke interpretation under 35 U.S.C. 112 6th paragraph, it would not be proper to import structure from the Specification into the claim. See MPEP § 2106 II.(C).

12. Applicants have enabled only a software configuration in their original disclosure (Specification, Page 12, Lines 24-33). However, the claim is not limited to only a software configuration. The claim also encompasses a hardware configuration for performing the receiving step. Because the claim encompasses both subject matter that is enabled and subject matter that is not enabled in the disclosure, claim 21 is rejected under 35 U.S.C. § 112 1st paragraph. See MPEP § 706.03.

Claim Rejections - 35 USC § 112 2nd Paragraph

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 17-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15. Claim 17 recites “receiving a request in a processor associated with said registry from a user to access a business entity definition comprising a plurality of information elements, each of

said information elements having permission details associated therewith” which renders the claim indefinite. One of ordinary skill in the art would not understand what the “permission details” are associated with. Do the information elements have permission details and the permission details are associated with the request? Are the permission details associated with the processor? Because one of ordinary skill in the art would not understand what the permission details are associated with, the claim is indefinite because the metes and bounds of the claim cannot be ascertained by one of ordinary skill in the art.

16. Also, one of ordinary skill in the art would not understand if it is the request or the business entity definition that is “comprising a plurality of information elements.” Again this prevents one of ordinary skill in the art from ascertaining the metes and bounds of the claim.

17. Claims 21 and 27 contain similar limitations and are rejected under the same rationales.

18. In claims 17-30, the phrase “business entity definition” is indefinite because—to one of ordinary skill in this art—the metes and bounds of the phrase can not be reasonably determined. First, the Examiner has carefully reviewed the original specification and can not locate, let alone ascertain, a lexicographic definition for this phrase. Second, the Examiner has again reviewed all documents of record in conjunction with MPEP §2141.03. Based upon this review and the review of the original specification, it is the Examiner’s position that the phrase “business entity definition” (as used in the context of these particular claims) is not known to those of ordinary skill in this art. However, if Applicant believes that the phrase *is* old and well known in the art, Applicant should (in their next appropriately filed response) expressly state on the record that the phrase is old and well known in the art and provide appropriate evidence in support thereof (*e.g.*

a U.S. patent). Upon receiving (1) Applicant's express statement that the phrase is old and well known in the art and (2) sufficient evidence in support thereof, the Examiner will withdraw this particular 35 U.S.C. §112 2nd paragraph rejection.

19. Claim 21 recites "[a] registry of business entity definitions, the registry comprising: at least one processor; and a computer readable memory." As noted in the previous Office Action, one of ordinary skill in the art would recognize a "registry of business entity definitions" as an arrangement of data (Paper – 20100203, Paragraph 54). Applicants have not argued this assertion. However, Applicants have added physical components (processor and memory) to the arrangement of data. Because of the addition of the physical components, one of ordinary skill in the art would not understand what the structure of a registry is.

20. In claim 25, the phrase "business service entity information element" is indefinite because—to one of ordinary skill in this art—the metes and bounds of the phrase can not be reasonably determined. First, the Examiner has carefully reviewed the original specification and can not locate, let alone ascertain, a lexicographic definition for this phrase. Second, the Examiner has again reviewed all documents of record in conjunction with MPEP §2141.03. Based upon this review and the review of the original specification, it is the Examiner's position that the phrase "business entity definition" (as used in the context of this particular claim) is not known to those of ordinary skill in this art. However, if Applicant believes that the phrase *is* old and well known in the art, Applicant should (in their next appropriately filed response) expressly state on the record that the phrase is old and well known in the art and provide appropriate

evidence in support thereof (*e.g.* a U.S. patent). Upon receiving (1) Applicant's express statement that the phrase is old and well known in the art and (2) sufficient evidence in support thereof, the Examiner will withdraw this particular 35 U.S.C. §112 2nd paragraph rejection.

21. In claims 25, the phrase "binding template information element" is indefinite because—to one of ordinary skill in this art—the metes and bounds of the phrase can not be reasonably determined. First, the Examiner has carefully reviewed the original specification and can not locate, let alone ascertain, a lexicographic definition for this phrase. Second, the Examiner has again reviewed all documents of record in conjunction with MPEP §2141.03. Based upon this review and the review of the original specification, it is the Examiner's position that the phrase "business entity definition" (as used in the context of this particular claim) is not known to those of ordinary skill in this art. However, if Applicant believes that the phrase *is* old and well known in the art, Applicant should (in their next appropriately filed response) expressly state on the record that the phrase is old and well known in the art and provide appropriate evidence in support thereof (*e.g.* a U.S. patent). Upon receiving (1) Applicant's express statement that the phrase is old and well known in the art and (2) sufficient evidence in support thereof, the Examiner will withdraw this particular 35 U.S.C. §112 2nd paragraph rejection.

22. In claims 25, the phrase "technical model information element" is indefinite because—to one of ordinary skill in this art—the metes and bounds of the phrase can not be reasonably determined. First, the Examiner has carefully reviewed the original specification and can not locate, let alone ascertain, a lexicographic definition for this phrase. Second, the Examiner has

again reviewed all documents of record in conjunction with MPEP §2141.03. Based upon this review and the review of the original specification, it is the Examiner's position that the phrase "business entity definition" (as used in the context of this particular claim) is not known to those of ordinary skill in this art. However, if Applicant believes that the phrase *is* old and well known in the art, Applicant should (in their next appropriately filed response) expressly state on the record that the phrase is old and well known in the art and provide appropriate evidence in support thereof (*e.g.* a U.S. patent). Upon receiving (1) Applicant's express statement that the phrase is old and well known in the art and (2) sufficient evidence in support thereof, the Examiner will withdraw this particular 35 U.S.C. §112 2nd paragraph rejection.

23. In claim 25, the phrase "business entity information element" is indefinite because—to one of ordinary skill in this art—the metes and bounds of the phrase can not be reasonably determined. First, the Examiner has carefully reviewed the original specification and can not locate, let alone ascertain, a lexicographic definition for this phrase. Second, the Examiner has again reviewed all documents of record in conjunction with MPEP §2141.03. Based upon this review and the review of the original specification, it is the Examiner's position that the phrase "business entity definition" (as used in the context of this particular claim) is not known to those of ordinary skill in this art. However, if Applicant believes that the phrase *is* old and well known in the art, Applicant should (in their next appropriately filed response) expressly state on the record that the phrase is old and well known in the art and provide appropriate evidence in support thereof (*e.g.* a U.S. patent). Upon receiving (1) Applicant's express statement that the phrase is old and well

known in the art and (2) sufficient evidence in support thereof, the Examiner will withdraw this particular 35 U.S.C. §112 2nd paragraph rejection.

24. The Examiner finds that because particular claims are rejected as being indefinite under 35 U.S.C. §112 2nd paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO's policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied as much as practically possible.

Claim Rejections - 35 USC § 102

25. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

26. Claims 17, 21, and 27, as understood by the Examiner, are rejected under 35 U.S.C. § 102(b) as being anticipated by Kramer (US 5,414,852).

27. As to claims 17, 21, and 27, Kramer shows:

- a. A method for a registry of business entity definitions to handle user requests to access business entity definitions, the method comprising:
- b. receiving a request in a processor (inherent to the computer because a computer needs a processor to execute anything, Title) associated with said registry (the data is

stored on the computer, Title) from a user (“a user requesting access at one end,” C 3, LL 50-51) to access a business entity definition (“data object,” C 3, L 36) comprising a plurality of information elements (“identifier of the original invoking user and the calling data managers,” C 4, LL 66-68), each of said information elements having permission details associated therewith (“A match must be found...in order for access to be allowed by the system level interface.” C 5, LL 1-2);

- c. obtaining the identity of the user from data associated with the request with said processor (“user identifier to identify an invoking user” with the invoking being the result of the request, Claim 1);
- d. determining with said processor, for each of said information elements, whether the user has permission to access that said information element (Figure 4) based on the permission details associated with that said information element (“Does user have permission for this type of access?” Step 68) and said identity of the user (“Is user on access list?” Step 64); and
- e. with said processor, denying the user access to those elements(Step 66) for which it is determined that the user does not have permission (if the answer to steps 64 or 68 are no, Figure 4).

Claim Rejections - 35 USC § 103

28. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

29. Claims 19, 20, 23, 24, 29, and 30, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kramer in view of Stefik (US 5,692,980).

30. Kramer teaches as set forth above in regards to claims 17, 21, and 27, but does not expressly show:

- f. determining with said processor whether the user has permission to access information in the business entity definition from permission details associated with the business entity definition and the identity of the user comprises determining with said processor whether a user has permission to access an information element from an access policy and permission details associated with a different information element; and
- g. the information elements are in a hierarchy and wherein determining with said processor whether the user has permission to access information in the business entity definition from permission details associated with the business entity definition and the identity of the user comprises determining with said processor that a user does not have permission to access a first information element if permission details associated with one or more second information elements directly beneath the first information element in the hierarchy indicate that user does not have access to one or more of the second information elements.

31. However, Stefik shows a root d-block **1101** corresponding to the business entity definition and child d-blocks **1102-1104** and **1105** corresponding to information elements. The root/child relationship is hierarchical. The root and each of the child d-blocks contains a separate "rights portion" (Figure 11). The root d-block **1101** gives the user access ("view") rights so the

user can see that the child d-blocks **1102-1104** and **1105** exist. For each of the d-blocks **1102-1103** and **1105** the user is shown to currently have an access ("view") right. For d-block **1104** the user does not currently have access because a fee is required. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Kramer to include the hierarchical structure of elements with separate permissions because it allows the creator of the elements a more granular control of the elements which in turn allows for additional revenue generation from charging a fee for access to particular data.

32. Claims 18, 22, 25, 26, and 28 rejected under 35 U.S.C. 103(a) as being unpatentable over Kramer in view of Solomon (US 2002/0046157).

33. Kramer teaches as set forth above in regards to claims 17, 21, and 27, but does not expressly show:

- h. the request specifies a search criteria, and wherein the method further comprises:
 - determining with said processor what information in the business entity definition the user wishes to access using the search criteria to locate the business entity definition; and
 - determining with said processor whether the user has permission to access the information that the user wishes to access;
- i. the registry is a UDDI registry and the information in the business entity definition is a business entity information element, the business entity information element containing one or more business service entity information elements, each business service entity containing one or more binding template information elements

and each binding template containing one or more references each referring to a technical model information element.

34. However, Solomon shows the conducting of searches being facilitated by a UDDI registry [0028]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Kramer to store the data in a UDDI in order to facilitate searching to allow the requestor to more easily find the desired information.

35. Claims 17, 21, and 27, as understood by the Examiner, are alternately rejected under 35 U.S.C. 103(a) as being unpatentable over Kramer in view of Stefik.

36. It is the Examiner's principle position that these claims are anticipated by Kramer as set forth above. The Examiner's position is that because a computer needs a processor to execute anything, a processor is inherent in the computer of Kramer. However, in case a reviewing body disagrees with this inherent teaching of Kramer, the Examiner provides the following alternate rejections.

37. As to claims 17, 21, and 27, Kramer shows:

- j. A method for a registry of business entity definitions to handle user requests to access business entity definitions, the method comprising:
 - k. receiving a request from a user ("a user requesting access at one end," C 3, LL 50-51) to access a business entity definition ("data object," C 3, L 36) comprising a plurality of information elements ("identifier of the original invoking user and the calling data

managers,” C 4, LL 66-68), each of said information elements having permission details associated therewith (“A match must be found...in order for access to be allowed by the system level interface.” C 5, LL 1-2);

l. obtaining the identity of the user from data associated with the request (“user identifier to identify an invoking user” with the invoking being the result of the request, Claim 1);

m. determining, for each of said information elements, whether the user has permission to access that said information element (Figure 4) based on the permission details associated with that said information element (“Does user have permission for this type of access?” Step 68) and said identity of the user (“Is user on access list?” Step 64); and

n. denying the user access to those elements(Step 66) for which it is determined that the user does not have permission (if the answer to steps 64 or 68 are no, Figure 4).

38. Kramer does not expressly disclose the performance of the recited steps by a processor.

39. However, Stefik shows a processor 1201 which is used to execute the software necessary to manage usage rights (C 14, LL 7-27). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Kramer to add a processor for executing the recited method steps because a processor is needed to have the computer of Kramer work.

Claim Interpretation

40. The term “processor” has been interpreted as an integrated circuit device used in computerized devices. Because Applicants only set forth a “processor” as corresponding to element 101 in a client/server (Specification, Page 5, Line 27), this is the only interpretation consistent with the instant specification. If Applicants desire any other interpretation, they should clearly state this intention in the next filed response and show support from their specification for the stated interpretation.

41. The Examiner hereby adopts the following interpretations under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his interpretation of the claims.¹ Additionally, these interpretations are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

- o. ***Associate***: “4 : to bring together or into relationship in any of various intangible ways (as in memory or imagination).” Webster’s Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.
- p. ***Configure***: “to set up for operation esp. in a particular way.” Webster’s Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield, M.A. 1986.

¹ While most definition(s) are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

- q. **For:** "I a -- used as a function word to indicate purpose... b -- used as a function word to indicate an intended goal" Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.
- r. **Information** " 2 a . . . (3): FACTS, DATA . . ." Merriam-Webster's Collegiate Dictionary, 10th Edition, Merriam-Webster Inc., Springfield, M.A., 1997.
- s. **To:** "2a -- used as a function word to indicate purpose, intention, tendency, result, or end." Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

Response to Arguments

42. Applicant's arguments filed 18 May 2010 have been fully considered but they are not persuasive.
43. Applicants argue:
44. "Claims 17-30 (formerly 16-29) were rejected as being indefinite under 35 U.S.C. § 112, second paragraph because the Examiner has not found a lexicographic definition for the phrase "business entity definition" and it is the Examiner's position that this phrase is "not known to those of ordinary skill in the art." (Action, p.13). This rejection is utterly improper and inappropriate, as the Examiner has not set forth adequate grounds of rejecting these claims". (Remarks, Page 14, Paragraph 3).

45. Examiner's response:

46. Applicants set forth passages from interparty decisions to support this argument.

However, the standard for indefiniteness during prosecution is not the same as during interparty proceedings.

“[W]e employ a lower threshold of ambiguity when reviewing a pending claim for indefiniteness than those used by post-issuance reviewing courts. In particular, rather than requiring that the claims are insolubly ambiguous, we hold that if a claim is amenable to two or more plausible claim constructions, the USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claim unpatentable under 35 U.S.C. § 112, second paragraph, as indefinite” (*Ex parte Miyazaki*, 89 USPQ2d 1207, 1211 (B.P.A.I. 2008)(precedential)).

Therefore, Applicant's arguments with respect to cases involving issued patents are not persuasive.

47. Applicants argue:

48. “If the specification makes the meaning of a claimed term clear, that term is plainly not indefinite under 35 U.S.C. § 112, second paragraph” (Remarks, Page 15, Paragraph 1).

49. Examiner's response:

50. The Examiner agrees.

51. Applicants argue:

52. "The term "business entity definition" is used throughout Applicant's specification as an entity in a registry, such as a Universal Description Discovery and Integration (UDDI) registry, through which a business entity publishes information about the services it provides in the form of definitions, each definition including one or more information elements" (Remarks, Page 15, Paragraph 2).

53. Examiner's response:

54. With all due respect, even this description is indefinite. It is not clear whether an "entity" is a part of a registry ("entity in a registry") or if it modifies the business ("business entity"). A definition of a business entity would be a description of the business, its sector, competitors, products, etc. under one reasonable interpretation. However, if the entity is part of the registry, the data contained in that entity would pertain to the business under another reasonable interpretation.

55. Applicants argue:

56. "[S]uch business entity definitions are well-known in the art in the context of UDDI registries. *See, e.g.*, UDDI Version 3.0.2 Specification http://www.uddi.org/pubs/uddi_v3.htm" (Remarks, Page 15, Paragraph 2).

57. Examiner's response:

58. With the exception of claim 26, the claims are not directed to a "UDDI registry."

59. Additionally, Applicants have referenced a document that is not of record. Because Applicants have not made the document of record properly, the Examiner has no basis to ascertain the date of publication. Because the date of publication is not known, the Examiner cannot make a determination whether the document is part of the prior art. Because the Examiner cannot make a determination whether the document is part of the prior art, the Examiner cannot determine if the document is valid for establishing that the phrase "business entity definition" is old and well known.

60. Applicants argue:

61. "Thus, the meaning of the term "business entity definition" is not indefinite under 35 U.S.C. § 112, second paragraph, because this term sets out and circumscribes a particular subject matter with a reasonable degree of clarity and particularity" in light of the "content of the particular application disclosure," the "teachings of the prior art," and "the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made." M.P.E.P. § 2173.01" (Remarks, Page 16, Paragraph 1).

62. Examiner's response:

63. First, for the reasons set forth above, Applicants are averring that they comply with the incorrect standard, the standard applied after issuance of a patent.

64. Second, while Applicants adamantly state the definition was known by one of ordinary skill in the art at the time of invention, they fail to particularly point out and distinctly recite this definition.

65. Applicants argue:

66. “Applicant notes that “[t]he examiner bears the initial burden...of presenting a *prima facie* case of unpatentability” (Remarks, Page 20, Paragraph 1).

67. Examiner's response:

68. The Examiner notes the rejection(s) above and in the previous action (Paper - 20100203) of each and every claim under at least 35 U.S.C. 112 2nd paragraph. These rejections alone represent a *prima facie* case of unpatentability. With respect to the rejections under §§ 102 and 103, the Examiner also directs Applicants’ attention to paragraph 47 of the previous action. The Examiner admits that the claims may not have been properly construed, however, the claims have been construed and art applied as much as practically possible. “35 U.S.C. 112, second paragraph, places the burden of precise claim drafting on the applicant” (*Ex parte Miyazaki*, 89 USPQ2d 1207, 1211 (B.P.A.I. 2008)(precedential)). Because drafting a definite claim is Applicants’ burden, when Applicants have not satisfied this burden, the Examiner is forced to apply art as much and as well as practically possible.

69. Because Applicants have limited the Examiner’s ability to properly construe the claim language, the arguments to the differences between the prior art and the claims are not persuasive until at least such time as the claims are rendered definite.

Conclusion

70. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

71. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

72. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The Examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m.

73. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

74. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joshua Murdough
Examiner, Art Unit 3621

/EVENS J. AUGUSTIN/
Primary Examiner, Art Unit 3621